

filter controls the display of video or music based on the content represented in the value information.

71. The system of claim 70 in which the filters provide information to the server about user preferences, and the server makes the information available to vendors of products, services, or information.

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SUBC5 72. (amended) A method in which a user of a commodity records value information on a client device or software about the commodity that is based on use of the commodity,

the client device or software sends the information to a server for storage, the client device receives from the server additional value information recorded by other users, and

the user [interacts] is presented with the additional value information in the course of working with the commodity.

REMARKS

Applicant's remarks below are preceded by quotations of relevant remarks of the examiner in bold-face, small type.

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 37 CFR 1.78 as follows: An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

It is noted that this application appears to claim subject matter disclosed in prior Application No. 08/934,457, and filed September 19, 1997. A reference to the prior application must be inserted as the first sentence of the specification of this application if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). Also, the current status of all nonprovisional parent applications referenced should be included.

The specification has been amended.

3. The disclosure is objected to because of the following informalities, for example:

page 5, lines 6,7,9,11,15,17 all begin with a period, these appear to be items which might be bulleted or indented, other similar occurrences are on page 37, 40, 41, 53-58, 62-63 and others;

page 31, the brief descriptions of figures 8 and 9 are identical, but the drawings are different;

the specification is also marked with various editing characters, see examples on page 30, line 29; page 31, lines 5, 10 and 13; page 36, lines 29 and 31.

Appropriate correction is required.

Applicant is submitting a substitute specification in the same manner as had been done for another sibling case.

5. Claims 48-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 48-66 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Specifically, the omitted elements of Claim 48 are:

receive information electronically regarding what value information would be necessary to make a product, service or information product valuable to the user, as perhaps a repository of customer desires or user-set preference flags, and

determining..., based upon triggers indicated by the customer desires database or user-set preferences..., useful for one of the clients (as indicated by in Figure 13 or Figure 23).

Amendments have been made.

7. Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Specifically, the omitted element of Claim 55 are: the ability of the software to determine what an "appropriate moment" is for displaying.

8. Claims 48-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Particularly, the use of the term "client" is confusing, at times it seems to refer to the device and other times to refer to the user of the device. For example, in Claim 48, lines 3, 10 and 17 seem to refer to the device, while line 10 seems to refer to a user of the elements. are: the device, but a

different user than referred to in line 6. Similar examples exist in Claims 58, 61, 62, and 65.

9. Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the term "appropriate moment" is confusing, because the phrase lacks a specificity which can be determined by the software.

Claim 55 has been amended.

10. Claim 72 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, lines 2, 7/8, and 10 refer to "value information" it is unclear if the "value information" of line 10 is the "value information" of line 2 or the "value information" of line 7~8. Also, the phrase "interacts with the value information" of line 9 is indefinite, it is unclear if the user is simply presented with the information or if the user must respond to further questions.

Claim 72 has been amended.

11. Claims 67, 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Kurland et al (4,603,232).

As per Claim 67.

Kurland et al ('232) discloses a digital medium storing information generated by large numbers of independent users about the value of products, services, software or information, the medium being coupled to an electronic communication to enable regular interchange of new value information from the users stored value information from the medium, see Column 4, line 61 - Column 5, line19.

Claim 67 has been amended to require "interchange of new value information from the users to the digital medium and of stored value information from the medium to the users." Applicant is unclear on where Kurland discloses or suggests that stored value information be provided from a digital medium "to the users.

As per Claim 69.

Kurland ('232) discloses all the limitations of Claim 67.

Kurland ('232) further discloses digital filters configured to identify patterns of sources of value information and fetch the identified information over the network, see Column 5, line 20 - Column 6, line 41.

12. Claims 68, 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland et al (4,603,232) as applied to claim 67 above, and further in view of Frost (5,041,972).

As per Claim 68.

Kurland ('232) discloses all the limitations of Claim 67.

Kurland ('232) does not disclose the users generate the new value information interactively while using the stored value information.

Frost (5,041,972) teaches users generating new value information interactively while using the stored value information, see Column 4, lines 34 - 50, for the benefit of selecting a set of attributes for market research which achieves the highest level of discrimination for each consumer interviewed.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Kurland ('232) to allow the users to generate new value information interactively while using the stored value information as taught by Frost ('972), for the benefit of selecting a set of attributes for market research which achieves the highest level of discrimination for each consumer interviewed.

Claims 68 and 69 are patentable for at least the same reasons as claim 67.

13. Claim 1 (sic--claim 48) would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claim 48 has been amended.

14. Claim 70 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Claim 71, which depends from Claim 70 would be allowable for the same reasons.

Claim 70 is patentable for at least the same reasons as claim 67.

15. Claim 72 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claim 72 has been amended.

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Applicant submits that all of the claims are now in condition for allowance, which action is requested.

Applicant also requests that the examiner confirm his review of the prior art publications cited in the information disclosure statement filed with this application on August 6, 1999, by returning a checked off Form 1449. Copies of the publications have already been filed in co-pending application Serial No. 09/369,392.

Please apply any additional charges or credits to deposit account 06-1050, reference 03058-004002.

Respectfully submitted,

Date: _____

7/14/00



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